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09/432,668	11/02/1999	YONATAN SILVER	U 013173-8	1351

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EXAMINER

SMITHERS, MATTHEW

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/432,668

**Applicant(s)**

SILVER, YONATAN

**Examiner**

Matthew B. Smithers

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-15,17-27 and 29-51 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 33-51 is/are allowed.  
6) ☒ Claim(s) 1-4,6-15,19,21-27 and 29-32 is/are rejected.  
7) ☒ Claim(s) 17,18 and 20 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Application***

Claims 5, 16, and 28 were canceled.

Claims 1,22, 23, 31, 32 were amended.

Claims 1-4, 9-15, 17-27 and 29-51 remain pending.

### ***Allowable Subject Matter***

Claims 33-51 are allowed.

Claims 17, 18, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed July 2, 2004 have been fully considered but they are not persuasive. Applicant argues the secondary reference, Guarantz (U.S. 5,936,660) does not teach a manufacturer, a salesperson or a user reprogramming a replaceable security element with preferences of the user to disable display of program at preselected time periods. Examiner respectfully disagrees and asserts the combination of Kinghorn and Guarantz does show a conditional access system where a user enters his/her specific preferences and the system enables/disables display of the programs based on the stored preferences. Kinghorn clearly shows a television system with conditional access where encoded programs are enable/disabled based on preferences

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of the user stored in a memory element. Gurantz shows a television system with a conditional access unit where a smartcard (removable memory element) is used to store a user's preferences. Based on the above, the examiner maintains the rejection of claims 1-4, 6-15, 19, 21-27 and 29-32, which is given below.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-15, 19, 21-27 and 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,020,882 granted to Kinghorn and further in view of U.S. patent 5,936,660 granted to Gurantz.

Regarding claim 1, Kinghorn teaches an access control method for receiving an encoded program at a subscriber unit via the broadcast communication network and preventing decoding of the encoded program at the subscriber unit for at least one preselected time period, preselected in accordance with a preference of a user of the subscriber unit, where the user selection/input is programmed (stored) into the memory element, wherein said step of preventing decoding comprises the step of disabling display of the program in a clear form at the subscriber unit for said at least one preselected time period (see abstract, column 6, lines 1-20, column 8, line 63 to column 9, line 23 and column 10, line 60 to column 11, line 12). Kinghorn fails to specifically

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teach using a removable security element (smartcard) to disable the data. Gurantz teaches a conditional access unit (subscriber unit) that uses a smartcard to authorize decryption (decoding) of video signals downloaded from the broadcaster. The smartcard has authorization data stored in it and uses the authorization information to determine if the programming material is to be displayed (see column 3, line 50 to column 4, line 18). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinghorn's Television access control system with Gurantz's video conversion system to gain the advantage of controlling a subscriber's authorizations through the use of an easily replaceable security element that can be reprogrammed. (see Gurantz, column 2, lines 4-19).

Regarding claim 2, Kinghorn as modified teaches wherein said step of preventing decoding comprises the step of disabling display of the program in a clear form at the subscriber unit for said at least one preselected time period in response to a selection inputted by the user (see Kinghorn', column 6, lines 37-40., column 7, lines 29-40 and column 8, lines 63-64).

Regarding claim 3, Kinghorn as modified teaches wherein said step of preventing decoding comprises the step of disabling display of the program in a clear form at the subscriber unit for said at least one preselected time period in response to disabling data inputted at a headend of the broadcast communication network (see Kinghorn, column 6, lines 3-9, column 6, lines 21-35., and column 6, lines 61-64).

Regarding claim 4, Kinghorn as modified teaches wherein said disabling data comprises addressed restriction information which is individually addressed to the subscriber unit (see Kinghorn, column 9, lines 35-40).

Regarding claim 6, Kinghorn as modified teaches wherein the disabling data (authorization data) is stored in the smart card before the smart card is provided to the user (see Gurantz, column 2, lines 13-19 and column 3, line 50 to column 4, line 18).

Regarding claim 7, Kinghorn as modified teaches wherein said disabling data comprises at least a portion of characteristics of the at least one preselected time period (see Kinghorn, column 8, lines 63-67).

Regarding claim 8, Kinghorn as modified teaches wherein said disabling data comprises characteristics of the at least one preselected time period (see Kinghorn, column 8, lines 63-67).

Regarding claim 9, Kinghorn as modified teaches wherein said characteristics of the at least one preselected time period comprise at least one of the following:

a beginning time of the at least one preselected time period and an ending time of the at least one preselected time period', and a beginning time of the at least one preselected time period and a length of the at least one preselected time period (see Kinghorn, column 10, line 60 to column 11, line 12 and Figure 7).

Regarding claim 10, Kinghorn as modified teaches wherein said characteristics of the at least one preselected time period comprise at least one of the following:

a beginning time of the at least one preselected time period and an ending time of the at least one preselected time period, a beginning time of the at least one

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preselected time period and a length of the at least one preselected time period, and a beginning time of the at least one preselected time period after the removable security element is inserted in a removable security element receptacle in said subscriber unit for a specified time period, and a time remaining to an end of a current day (see Kinghorn, column 10, line 60 to column 11, line 12 and Figure 7).

Regarding claim 11, Kinghorn as modified teaches wherein said step of preventing decoding comprises the step of disabling display of a program in a clear form at a channel to which the subscriber unit is tuned during said at least one preselected time period (see Kinghorn, column 8, lines 7-36 and column 9, lines 9-14).

Regarding claim 12, Kinghorn as modified teaches wherein said step of preventing decoding comprises the step of disabling display of a pay program in a clear form at a channel to which the subscriber unit is tuned during said at least one preselected time period (see Kinghorn, column 8, lines 7-36 and column 9, lines 9-14).

Regarding claim 13, Kinghorn as modified teaches wherein said program comprises at least one of the following: a television program, a pay television program, a commercial, a video clip, a program guide, an electronic program guide (EPG), data, multimedia information, a hypermedia link, a computer program, computer data, an application which may be downloaded, a program applet, teletext information, an audio program, a textual information program, an image generating program, electronic-mail, and voice mail (see Kinghorn, column 6, lines 1-20., column 8, lines 7-36 and column 9, lines 9-14).

Regarding claim 14, Kinghorn as modified teaches wherein said at least one preselected time period comprises at least one of the following: a periodic time period, and a specific time period (see Kinghorn, column 10, line 60 to column 11, line 12 and Figure 7).

Regarding claim 15, Kinghorn as modified teaches wherein said step of preventing decoding comprises the steps of: generating a disabling code in response to said selection inputted by the user; and employing said disabling code to prevent decoding of said program for said at least one preselected time period (see Kinghorn, column 6, lines 37-40, column 6, lines 49-52, column 7, lines 29-40 and column 8, lines 63-64).

Regarding claim 19, Kinghorn as modified teaches wherein said step of preventing decoding comprises the steps of: employing disabling code (authorization data) resident in the removable security element (see Gurantz, column 3, line 50 to column 4, line 19).

Regarding claim 21, Kinghorn as modified teaches wherein said at least one preselected time period is selected to immediately follow an additional time period during which programs broadcast via the broadcast communication network are displayed in a clear form (see Kinghorn, column 10, line 60 to column 11, line 12).

Regarding claim 22, Kinghorn teaches an access control method for receiving an encoded program at a subscriber unit via the broadcast communication network, and enabling decoding of the encoded program at the subscriber unit for at least one preselected time period, preselected in accordance with a preference of a user of the



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subscriber unit, wherein said step of preventing decoding comprises the step of disabling display of the program in a clear form at the subscriber unit for said at least one preselected time period (see abstract', column 6, lines 1-20., column 8, line 63 to column 9, line 23 and column 10, line 60 to column 11, line 12). Kinghorn fails to specifically teach using a removable security element (smartcard) to disable the data. Gurantz teaches a conditional access unit (subscriber unit) that uses a smartcard to authorize decryption (decoding) of video signals. The smartcard has authorization data stored in it and uses the authorization information to determine if the programming material is to be displayed (see column 3, line 50 to column 4, line 18). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinghorn's Television access control system with Gurantz's video conversion system to gain the advantage of controlling a subscriber's authorizations through the use of an easily replaceable security element that can be reprogrammed. (see Gurantz, column 2, lines 4-19).

Regarding claim 23, Kinghorn teaches an apparatus at a subscriber unit for providing access control to broadcast transmissions, the apparatus comprising: a receiver and decoder unit operative to receive and decode a program broadcast via a broadcast communication network in an encoded form', and a processor operatively associated with the receiver and decoder unit and operative to disable decoding of the program at the receiver and decoder unit for at least one preselected time period, preselected in accordance with a preference of a user of the subscriber unit, wherein said step of preventing decoding comprises the step of disabling display of the program

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in a clear form at the subscriber unit for said at least one preselected time period (see column 6, lines 33-40 and column 8, lines 7-36). Kinghorn fails to specifically teach using a removable security element (smartcard) to disable the data. Gurantz teaches a conditional access unit (subscriber unit) that uses a smartcard to authorize decryption (decoding) of video signals. The smartcard has authorization data stored in it and uses the authorization information to determine if the programming material is to be displayed (see column 3, line 50 to column 4, line 18). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kinghorn's Television access control system with Gurantz's video conversion system to gain the advantage of controlling a subscriber's authorizations through the use of an easily replaceable security element that can be reprogrammed (see Gurantz, column 2, lines 4-19).

Regarding claim 24, Kinghorn as modified teaches a user input device operatively associated with said processor and operative to enable input of data determining said at least one preselected time period (see Kinghorn, column 6, lines 49-51).

Regarding claim 25, Kinghorn as modified teaches wherein said user input device comprises at least one of the following: a keypad', a remote control unit; and a mouse pointer (see Kinghorn, column 6, lines 49-51).

Regarding claim 26, Kinghorn as modified teaches a memory for storing data determining said at least one preselected time period (see Kinghorn, column 8, lines 61-67).

Regarding claim 27, Kinghorn as modified teaches wherein said receiver and decoder unit is also operative to receive the program with a disabling code associated therewith, to separate the disabling code from the program, and to provide the disabling code to the processor, and said processor is also operative to determine whether the disabling code is addressed to the subscriber unit, and to prevent decoding of the program for said at least one preselected time period if the disabling code is addressed to the subscriber unit (see Kinghorn, column 9, lines 35-40).

Regarding claim 29, Kinghorn as modified teaches a removable security element (see Gurantz, column 3, lines 60-63).

Regarding claim 30, Kinghorn as modified teaches a smart card (see Gurantz, column 3, lines 60-63).

Claim 31 is an apparatus claim that is substantially equivalent to method claim 1.

Therefore claim 31 is rejected by a similar rationale.

Claim 32 is an apparatus claim that is substantially equivalent to method claim 22.

Therefore claim 32 is rejected by a similar rationale.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Matthew B Smithers  
Primary Examiner  
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